

**REMARKS**

A review of the claims revealed an obvious inaccuracy in recitation in that the carbon to which the R<sub>1</sub> group is attached has only one open valence and it is therefore impossible for any particular R<sub>1</sub> group to be a combination of H and methyl. It is apparent from the disclosure at page 5, lines 8-9 that when the polyalkene oxide is a copolymer of ethylene and propylene oxides that the individual R<sub>1</sub> groups will be either H or methyl. An appropriate correction has therefore been made. In addition, an obvious typographical error in claim 13 has been corrected.

It is respectfully submitted that the rejection under 35 U.S.C. § 112, second paragraph, of claims 4-6 because the reference to "average molecular weight" is "confusing" should be withdrawn. Those skilled in the art would be well aware just from reading this application what average molecular weight is being referenced. For example, as noted on page 2 of the application, U.S. Patent 4,496,686 discloses a dispersant obtained by reacting a polycarboxylic acid anhydride having a molecular weight of 100-4000 and review of that patent shows that it simply refers to the average molecular weight without further definition. Likewise, the Vickers reference on which the prior art rejections rely also simply refers to the average molecular weight without further definition. See column 9. It is respectfully submitted that the rejection of claims 10 and 11 under 35 U.S.C. 112, second paragraph, has been rendered moot by making explicit that was previously implicit, namely that the compound is added to the ink.

Withdrawal of the Section 112 rejection is respectfully solicited.

The rejection of claims 1-6 and 12-16 under 35 U.S.C. 103 over Hartman in view of Vickers and either Paulson or Walker is respectfully traversed.

The rejected claims relate to a compound which is used as a dispersant in printing inks. The compound is clearly novel as evidenced by the absence of a rejection

under 35 U.S.C. 102. It is also unobvious and has surprising and unexpected properties.

The Hartman patent relates to an alkyl- or aryl-terminated polyamide composition. The polyamide is the reaction product of one or four difference reactions which are (a) reacting a polycarboxylic acid with a monoamine, (b) reacting a polycarboxylic acid with both a monoamine and a polyamine of formula II, (c) reacting a polyamine with a monocarboxylic acid and (d) reacting a polycarboxylic acid with a polyamine of formula III and a monocarboxylic acid. The term polycarboxylic acid includes any and all aliphatic or aromatic carboxylic acids having a functionality of at least 2 as well as the corresponding acid anhydrides, esters and acid halides (column 4, lines 18-21). The term monoamine means any and all aliphatic or aromatic primary or secondary amines having a functionality of 1 (column 4, lines 29-31) and the polyamines are all those having a functionality of about 2. Given the immense scope of this disclosure, it is hardly surprising that the compound of the rejected claims might be within the generic scope of this patent. Indeed millions, if not billions, of compounds are within that scope. There is however, no species within this immense scope falling within the rejected claims nor is there any teaching or suggestion which would lead one skilled in the art to select the proper one of the four reaction schemes and then select the proper reactants in order to realize the present invention.

Even beyond the foregoing, the Hartman compounds are rheological additives that function as a slag-slump control agents. There is nothing in this reference which teaches or suggests that any compound within its scope can be used as a dispersing agent for printing inks.

The secondary references do not cure any of the deficiencies of Hartman. The Vickers reference has been cited solely to show that the same compound is referenced under two different trade names, namely XTJ-508 and M-2070. This

disclosure is found in the middle of a reference which deals with additives for cementitious compositions. Paulson teaches a polyether amide which is the reaction product of a polyalkylene diamine and a polycarboxylic acid. Like Hartman, the scope of this reaction product is enormous. There is a reference in Paulson to M-2070 in column 7 but the disclosure in that column is only that this is one of the types of polyoxyalkylene monamines or ether-based monoamines which can be used to terminate the polyetheramide which is the reaction product of a diamine and a polycarboxylic acid. The Paulson polyether amides are used to improve adhesion characteristics in protective and decorative coatings.

The last secondary reference, Walker, teaches the reaction product of a poly(alkylene oxide) monoamine or diamine with a di- or polycarboxylic acid and indicates that among the myriad monoamines which can be employed is M-2070. The Walker reaction product is taught to be an epoxy hardener.

In summary, all of the four references on which this rejection is based have extremely broad disclosures from which bits and pieces, if appropriately extracted from the individual references combined in a particular way, might possibly result in the formation of a compound of the rejected claims. There is, however, no teaching or suggestion which would lead one skilled in the art to do so. Even if motivation was present, and no motivation is present, one skilled in the art would not make the combination proposed given that each of the references is in a different technology, namely a slag/slump control agent, cement additive, adhesion improver for a protective coating and an epoxy hardener. There is no question that this rejection is based on an attempted hindsight reconstruction of the invention using the application text as a template. There is no apparent reason for the selection of these four references other than that they are the result of a computer search designed after having read the present application. This is clearly improper for obviousness purposes.

This hindsight nature of the combination is further apparent from the acknowledgement that there is no teaching or suggestion in these references that the compound of the claims can be a polymeric dispersant and the necessity in the Office Action to allege that the compounds would "intrinsically" have various characteristics or function. It is also to be noted that these assertions are predicated on the assumption that the prior art teaches or suggests the compounds claimed which, of course, they do not. The attempt to ignore the fact that the compounds have the dispersant, etc., properties by trying to ignore the preamble of the claims is, it is respectfully submitted, improper since a compound and its properties are not separable. Whether or not the preamble refers to a dispersant, etc., the fact that these compounds have the properties of a dispersant, etc., is surprising and unexpected.

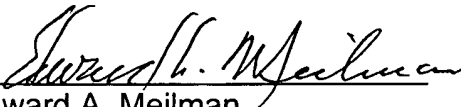
Claims 7-11 have been rejected under 35 U.S.C. 103 over Mahmud in view of Hartman, Vickers and either Paulson or Walker. This rejection is respectfully traversed.

The Mahmud reference has been cited solely to teach that inks may contain a rheological additive. The relevant disclosure is simply "Rheological additives are often added to adjust such flows" (col. 3, lines 19-20). Thus, Mahmud teaches at best inks exist and may contain something other than a colorant. The combination of Hartman, Vickers, Paulson and Walker has been discussed above. That discussion is equally applicable here and in fact is reinforced by the fact that none of those references relate to inks. The only secondary reference which makes some reference to a rheological agent is Hartman but that reference teaches the agent disclosed is a slag-slump control agent for sealants, etc. Here also the combination applied in this rejection is clearly based on hindsight using the present application as a template.

In light of the foregoing considerations, it is respectfully submitted that this application is in condition to be allowed and the early issuance of a Notice of Allowance is respectfully solicited.

Dated: November 23, 2006

Respectfully submitted,

By   
Edward A. Meilman

Registration No.: 24,735  
DICKSTEIN SHAPIRO LLP  
1177 Avenue of the Americas  
New York, New York 10036-2714  
(212) 277-6500  
Attorney for Applicants

EAM/jms/mgs